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EXAMINER

AUGUSTIN, EVENS J

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* LANE W. LEE, TIMOTHY R. FELDMAN, DOUGLAS M.  
9 RAYBURN, and GARY G. KIWIMAGI  
10

11  
12 Appeal 2009-000689  
13 Application 09/940,174  
14 Technology Center 3600  
15

16  
17 Decided: November 10, 2009  
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21 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W.  
22 FETTING, *Administrative Patent Judges*.

23  
24 CRAWFORD, *Administrative Patent Judge*.  
25

26  
27 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-3. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented systems and methods in the field of digital rights managements that ensure that content is accessed, copied, and controlled in secure ways in an electronic environment (Spec. 2:11-13).

Claim 1 under appeal is further illustrative of the claimed invention as follows:

1. A method of detecting unauthorized actions with respect to content on an optical disk, the optical disk including a read-only portion for pre-recorded content and a writeable portion for written content, the method comprising:

reading an identifier on the optical disk;

determining whether the identifier was located in the read-only or the writeable portion of the optical disk;

determining whether the identifier identifies itself as a pre-recorded identifier or as a written identifier;

and if the identifier identifies itself as a pre-recorded identifier and is located in the writeable portion of the optical disk, detecting an unauthorized action solely from the pre-recorded identifier being located in the writeable portion.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ram	US 6,519,700 B1	Feb. 11, 2003
Morito	US 6,782,190 B1	Aug. 24, 2004

1 The Examiner rejected claims 1-3 under 35 U.S.C. § 102(e) as being  
2 anticipated by Morito; and rejected claim 3 under 35 U.S.C. § 103(a) as  
3 being unpatentable over Morito in view of Ram.<sup>1</sup>

4 We REVERSE.

5  
6 ISSUE

7 Did the Appellants show the Examiner erred in asserting that Morito  
8 discloses

9 determining whether the identifier identifies  
10 itself as a pre-recorded identifier or as a written  
11 identifier;

12 and if the identifier identifies itself as a pre-  
13 recorded identifier and is located in the writeable  
14 portion of the optical disk, detecting an  
15 unauthorized action solely from the pre-recorded  
16 identifier being located in the writeable portion[.]

17 as recited in independent claim 1, because Morito requires comparing the  
18 identifiers in the read-only part 2 and data area 3 of disk 1 in order to detect  
19 an unauthorized action?

20  
21 FINDINGS OF FACT

22 *Specification*

23 Appellants invented systems and methods in the field of digital rights  
24 managements that ensure that content is accessed, copied, and controlled in  
25 secure ways in an electronic environment (Spec. 2:11-13).

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<sup>1</sup> Claims 9, 15, 17, 18, 21, and 22 were cancelled by Appellants in the Amendment under 37 C.F.R. § 41.33 filed November 8, 2007. The Amendment was acknowledged by the Examiner in the amended “Status of Claims” section mailed October 7, 2008.

1 *Morito*

2 Morito discloses a DVD disk 1 with identification area 2 and data area  
3 3. Identification area 2 is located on a read-only part of the disk, so that only  
4 the manufacturer of the disk can write information to this area during  
5 manufacture of the disk 1 (col. 4, ll. 20-24).

6 The manufacturer produces a blank disk that includes a unique serial  
7 number or disk identifier  $S_p$  in identification area 2 (col. 4, ll. 55-57; col. 5,  
8 ll. 64-67).

9 Disk 1 also includes disk identifier  $S_d$  in data area 3 (col. 5, ll. 61-64).

10 If the original disk has not been copied, the two identifiers will be  
11 identical and a signal will be sent to the playback device 16 indicating that  
12 the disk can be played. If the original disk has been copied, then the disk  
13 identifier  $S_p$  in the burst cutting area 2 of the new disk will be different from  
14 the original disk identifier  $S_d$  copied over to data area 3 of the new disk. In  
15 this case, a signal is sent to the playback device 16 that the disk is an  
16 unauthorized copy and therefore cannot be played (col. 6, ll. 3-14).

17

## 18 PRINCIPLES OF LAW

19 *Anticipation*

20 “A claim is anticipated only if each and every element as set forth in  
21 the claim is found, either expressly or inherently described, in a single prior  
22 art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628,  
23 631 (Fed. Cir. 1987).

24

ANALYSIS

We are persuaded of error on the part of the Examiner by Appellants' argument that because Morito requires comparing the identifiers in the read-only part 2 and data area 3 of disk 1 in order to detect an unauthorized action, Morito does not disclose

determining whether the identifier identifies itself as a pre-recorded identifier or as a written identifier;

and if the identifier identifies itself as a pre-recorded identifier and is located in the writeable portion of the optical disk, detecting an unauthorized action solely from the pre-recorded identifier being located in the writeable portion[.]

as recited in independent claim 1 (App. Br. 6-7; Reply Br. 4-6). Morito discloses comparing disk identifiers  $S_p$  and  $S_d$  on respective disk areas 2 and 3 to determine whether disk 1 is an unauthorized copy. Accordingly, the portions of Morito cited by the Examiner do not disclose that any determination is made whether disk identifiers  $S_p$  and  $S_d$  are different types/formats of identifiers as recited in independent claim 1. Morito treats all disk identifiers  $S_p$ ,  $S_d$  as the same type/format.

Moreover, even if different "types" merely meant different identifiers in the same format, and one could arguably determine the type of identifier after disk identifiers  $S_p$ ,  $S_d$  have been compared (e.g., if the disk identifiers  $S_p$ ,  $S_d$  are different, disk identifier  $S_d$  must have come from disk area 2 of another disk 1) independent claim 1 recites "detecting an unauthorized action *solely* from the pre-recorded identifier being located in the writeable portion" (emphasis added). Thus, in order to anticipate the aforementioned recitation, Morito would have to disclose that the presence of disk identifier  $S_d$  on disk area 3 alone causes the detection of the unauthorized action.

1 However, without comparing disk identifiers  $S_p$ ,  $S_d$ , one cannot determine  
2 the type of identifier that disk identifier  $S_d$  on disk area 3 embodies that is  
3 necessary to determine the presence of the unauthorized action.

4 Accordingly, because more steps are necessary, other than locating the  
5 presence of disk identifier  $S_d$  on disk area 3, to determine the identifier type  
6 necessary to determine the presence of the unauthorized action, Morito does  
7 not disclose “detecting an unauthorized action *solely* from the pre-recorded  
8 identifier being located in the writeable portion” (emphasis added) as recited  
9 in independent claim 1. We do not sustain the rejection of independent  
10 claim 1.

11 It is true that the last paragraph of independent claim 1 contains a  
12 conditional “if” recitation. In certain circumstances the recitation is  
13 optional, and thus the cited reference would not need to disclose the  
14 conditional “if” recitation to anticipate the claim. However, because the two  
15 “providing” paragraph recitations must be performed, and certain results  
16 from the two “providing” paragraph recitations necessitate the performance  
17 of the conditional “if” recitation, in this situation, the conditional “if”  
18 recitation must be disclosed in the cited reference in order to anticipate  
19 independent claim 1.

20 By virtue of their dependence on independent claim 1, we also do not  
21 sustain the rejection of dependent claims 2 and 3.

## 22 23 CONCLUSION OF LAW

24 On the record before us, Appellants have shown that the Examiner  
25 erred in rejecting claims 1-3.

1 DECISION

2 The decision of the Examiner to reject claims 1-3 is reversed.

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4 REVERSED

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